

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated May 22, 2007 (hereinafter Office Action) have been considered. Claims 1-60 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

In the Office Action, the Examiner indicates that claims 1-60 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-57 of U.S. Patent No. 7,047,071 to Wagner et al. (hereinafter "Wagner"). The Examiner also indicates that claims 9, 10, 16, 17, 25, 26, 28-33, 37-40, 42, 43, 46, 47, 49, 51, 52, 59 and 60 would be allowable if a terminal disclaimer were filed to overcome the nonstatutory obviousness-type double patenting. Claims 1-8, 11-15, 18-24, 27, 34-37, 41, 44, 45, 48, 50 and 53-58 are rejected based on 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,235,246 to Weiss in view of U.S. Patent No. 6,148,230 to KenKnight.

As required by the Examiner, Applicant submits herewith a terminal disclaimer executed by Applicant's Representative that overcomes the nonstatutory obviousness-type double patenting rejection of the claims. Applicant has elected to further prosecute claims directed to the allowable subject matter indicated by the Examiner in the Office Action.

In particular, claim 1 has been amended to include allowable subject matter of claim 9, now canceled without prejudice or disclaimer. Claim 18 has been amended to include allowable subject matter of claim 28. Claim 27 has been amended to include allowable subject matter of claim 31, now canceled without prejudice or disclaimer. Claim 44 has been amended to include allowable subject matter of claim 47, now canceled without prejudice or disclaimer. Claim 48 has been amended to include allowable subject matter of claim 49, now canceled without prejudice or disclaimer. Claim 50 has been amended to include allowable subject matter of claim 51, now canceled without prejudice or disclaimer. Claim 53 has been amended to include allowable subject matter of claim 59, now canceled without prejudice or disclaimer. Claims 10, 39, and 60 have been amended to harmonize dependency of these claims in view of the amendments made to their respective base claims.

The Applicant has further amended the independent claims to recite skin surface electrodes in each of these claims. The Applicant, in its prior response, argued that one of ordinary skill in the art would understand, particularly in light of the Applicant's specification, that "surface electrodes", as recited in the Applicant's claims, does not refer to implanted electrodes or electrodes otherwise used within a patient's body. For example, the Applicant's specification states that "the use of the surface electrodes allows the patient not to be subjected to surgery before he/she is determined to be a candidate for the subcutaneous defibrillation system." (Page 30, Lines, 21-23; emphasis added).

Furthermore, surface electrodes are recognized and understood in the art as electrodes that are not implanted or otherwise used within a patient's body, particularly in light of the Applicant's specification. For example, U.S. Patent No. 6,754,517 recites "an outer surface electrode (122) to be arranged against a point on the person's skin." (Abstract). Also, U.S. Patent No. 7,043,308 recites "a system and method of providing electrical stimulation via the skin of a patient, by means of an inventive surface electrode." (Col. 1, Lines 8-10). In addition, U.S. Patent No. 5,176,676 recites "a flexible surface electrode for carrying current to and from the skin of a human body." (Col. 1, Lines 6-8). The Applicant respectfully submits that these references illustrate that one of ordinary skill in the art would understand a surface electrode to be an electrode that is not implanted or otherwise used within a patient's body, at least within the context of the Applicant's specification.

The Applicant respectfully submits that both of the *Weiss* and *KenKnight* references only disclose the use of subcutaneous electrodes and do not contemplate the use of surface electrodes.

Weiss discloses an epicardial lead with an insertion assembly for attaching the lead to the heart wall. (Abstract). *Weiss* discloses that the leads can be tested on various areas of the heart wall before being permanently attached to the heart wall. (Col. 5, Lines 1-29). *Weiss* does not disclose, or suggest using, surface electrodes, as all electrodes disclosed by *Weiss* require contact with the heart or at least insertion into the body proximate the heart.

KenKnight discloses a cardiac monitoring device and a plurality of subcutaneous cardiac sensing electrodes electrically connected to the monitoring device. (Abstract).

KenKnight states that “subcutaneous sensing electrodes described herein are positioned on the thorax of the patient, preferably on the left side and on the ventral surface (that is, on the chest).” (Col. 2, Lines 41-44). The Applicant respectfully submits that even though *KenKnight*’s subcutaneous sensing electrodes are “positioned on the thorax,” these sensing electrodes are nevertheless subcutaneous electrodes that are implanted below the surface of the skin. (See Col. 3, Lines 8-33).

The Applicant respectfully submits that *Weiss*’ heart wall contacting electrodes and *KenKnight*’s subcutaneous electrodes are not surface electrodes. Therefore, neither of these references teach or suggest the use of surface electrodes.

The Applicant’s amendment of the independent claims to include the term “skin” in the recitation of surface electrodes merely makes express that which is inherent in the original claims. An amendment that only make express a recitation of a feature that was already inherent in the original claim is not a narrowing of the scope of the properly construed claim. *TurboCare v. General Electric Co.*, 264 F.3d 1111 (Fed. Cir. 2001); *Bose Corp. v. JBL, Inc.*, 274 F.3d 1354 (Fed. Cir. 2001) and *Interactive Pictures Corp. v. Infinite Pictures, Inc.*, 274 F.3d 1371 (Fed. Cir. 2001).

The Applicant has elected to further prosecute claims directed to the allowable subject matter indicated by the Examiner in the Office Action. It is to be understood that the Applicant’s election does not constitute acquiescence to the Examiner’s rejection of the claims on substantive art grounds, and maintains the arguments regarding patentability of the rejected claims presented in the previous responsive communication. In particular, the Applicant does not acquiesce to the Examiner’s characterization of the asserted art or the Applicant’s claimed subject matter, nor of the Examiner’s application of the asserted art to the Applicant’s claimed subject matter. The Applicant reserves the right to address the Examiner’s characterizations and rejections when prosecuting the rejected claims in one or more continuing applications.

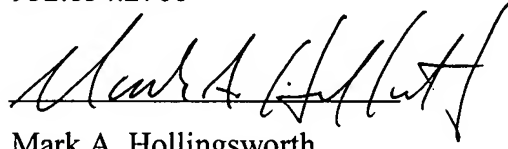
Authorization is given to charge Deposit Account No. 50-3581 (GUID.628PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the Examiner is invited to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC
8009 34th Avenue South, Suite 125
Minneapolis, MN 55425
952.854.2700

Date: October 22, 2007

By:

A handwritten signature in black ink, appearing to read "Mark A. Hollingsworth", written over a horizontal line.

Mark A. Hollingsworth
Reg. No. 38,491